

### **REMARKS**

This paper responds to the Office Action dated September 2, 2009. Claims 17, 28, 33, 35, and 36 are amended herein. Claims 1-16 were previously canceled, and claim 26 is canceled herein. Claims 37-41 were previously withdrawn. No claims are added herein. As a result, claims 17-25 and 27-36 remain pending examination in this application.

#### **§ 101 Rejections of the Claims**

Claims 17-36 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.<sup>1</sup> The United States Court of Appeals for the Federal Circuit (CAFC) has held that satisfaction of the machine-or-transformation test imparts patent eligibility under § 101.<sup>2</sup> “The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.”<sup>3</sup> Moreover, “the use of a specific machine or transformation of an article must impose meaningful limits on the claim’s scope to impart patent eligibility.”<sup>4</sup> Furthermore, “the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.”<sup>5</sup>

Claim 17 is amended herein to recite, in part, “the providing of the answer being performed by a **module** implemented using a **processor** of a **machine**.”<sup>6</sup> The method of claim 17 is tied to a particular machine, namely, the machine having the processor that implements the module. The use of this machine imposes meaningful limits on the claim’s scope, because the providing of the answer must be performed by the module implemented using a processor of the machine. The involvement of this machine is not insignificant extra-solution activity. While the Office Action asserted that “the providing step . . . only encompasses a **displaying** of the answer

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<sup>1</sup> Office Action, page 7.

<sup>2</sup> *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d (BNA) 1385 (Fed. Cir. 2008).

<sup>3</sup> *Id.*, at 961.

<sup>4</sup> *Id.*, at 961.

<sup>5</sup> *Id.*, at 962.

<sup>6</sup> Claim 17, emphasis added.

on a webpage which is considered an insignificant extra-solution activity,”<sup>7</sup> Applicants’ specification explicitly states that “seller-controlled **publication of question and answer sets** is described.”<sup>8</sup> Applicants therefore respectfully submit that the providing step is not insignificant with respect to the purpose of the claimed method. Furthermore, the presence of one or more processors to perform an action effectively ties the claims were particular machine.<sup>9</sup> As recited in claim 17, the processor is present in the module to perform the providing of the answer. As a result, claim 17 and its dependent claims 18-25 and 27 satisfy the machine branch of the machine-or-transformation test and are therefore directed to patentable subject matter under § 101. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

Claim 28 is amended herein to recite, in part “a **processor . . .**; and instructions to be executed . . . by the processor . . . to cause the processor **to perform operations comprising: providing the answer.**”<sup>10</sup> The system of claim 28 is tied to a particular machine, namely, the machine having the processor to execute the instructions and to provide the answer. The use of this machine imposes meaningful limits on the claim’s scope, because the processor must execute the instructions and provide the answer. The involvement of this machine is not insignificant extra-solution activity. While the Office Action asserts that “the providing step . . . only encompasses a **displaying** of the answer on a webpage which is considered an insignificant extra-solution activity,”<sup>11</sup> the functionality of providing the answer is not insignificant with respect to the purpose of the claimed system, as discussed above with respect to claim 17. As result, claim 28 and its dependent claims 29-34 satisfy the machine branch of the machine-or-transformation test and are therefore directed to patentable subject matter under § 101. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

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<sup>7</sup> Office Action, page 7, emphasis added.

<sup>8</sup> U.S. Published Patent Application No. 2005/0015325, paragraph 0030, emphasis added; *see also id.* at title, “**SELLER-CONTROLLED PUBLICATION OF QUESTION AND ANSWER SETS**,” emphasis added.

<sup>9</sup> *See* Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101, page 5 (August 24, 2009).

<sup>10</sup> Claim 28, emphasis added.

<sup>11</sup> Office Action, page 7, emphasis added.

Claim 35 is expressed in “means-plus-function” language and recites, in part, “[a] **system**.”<sup>12</sup> Applicants respectfully submit that a **system** constitutes statutory subject matter under § 101. Furthermore, “[a]n element in a claim for a combination may be expressed as a **means or step for** performing a specified function **without the recital of structure**, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”<sup>13</sup> Thus, Applicants respectfully request that this rejection be reconsidered and withdrawn and that the claim be allowed.

Claim 36 recites, in part, “[a] **machine-readable medium** comprising instructions.”<sup>14</sup> According to the MPEP, “[w]hen a computer program is recited **in conjunction with a physical structure**, such as a computer memory, USPTO personnel should treat the claim as a **product claim**.”<sup>15</sup> A machine-readable medium is a physical structure. Accordingly, claim 36 should be treated as a product claim, as explicitly set forth in the MPEP. Thus, Applicants respectfully request that this rejection be reconsidered and withdrawn and that the claim be allowed.

### § 112 Rejection of the Claims

Claim 35, which is expressed in “means-plus-function” language, was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. According to the MPEP:

If [no additional] form paragraphs are appropriate, **a full explanation of the deficiency of the claims should be supplied**. Whenever possible, identify the particular term(s) or limitation(s) which render the claim(s) indefinite and state why such term or limitation renders the claim indefinite.<sup>16</sup>

Applicants respectfully submit that the Office Action contains no explanation of the asserted deficiency of the claims. While the Office Action, on pages 2-6, contains several paragraphs of

<sup>12</sup> Claim 35, emphasis added.

<sup>13</sup> 35 U.S.C. § 112, paragraph 6, emphasis added.

<sup>14</sup> Claim 36, emphasis added.

<sup>15</sup> MPEP 2106.01(I), fourth paragraph, emphasis added.

<sup>16</sup> MPEP 706.03(d), discussing form paragraph 7.34.01, emphasis added.

quotations from other cases,<sup>17</sup> nothing in the Office Action discusses any specific deficiency alleged with respect to claim 35. As a result, Applicants respectfully submit that the § 112 rejection is unsupported and that the Office Action failed to supply a full explanation of the asserted deficiency of the claim.

To the extent that the Examiner may be attempting to assert that Applicants' specification fails to recite corresponding structure to perform the functions recited in claim 35, Applicants' specification does recite corresponding structure to perform the functions recited in claim 35. For example, FIG. 1 and paragraphs 0036- 0041 of Applicants' specification describe a **"commerce system 10 [that] includes one or more of a number of types of front-end servers that each includes at least one Dynamic Link Library (DLL) to provide certain functionality."**<sup>18</sup> According to Applicants' specification, among other functions, "the commerce system 10 receives the indication to publish the question and answer."<sup>19</sup> Moreover, FIG. 14 and paragraphs 00129-00132 of Applicants' specification discuss a **"machine in the exemplary form of a computer system within which a set of instructions, for causing the machine to perform any one of the methodologies discussed above, may be executed."**<sup>20</sup> A machine is a physical structure, and a machine to perform the functionality of the commerce system is also a physical structure. As result, the "means-plus-function" language of claim 35 is fully supported by explicit recitation of a physical structure in Applicants' specification. Thus, Applicants respectfully request that this rejection be reconsidered and withdrawn and that the claim be allowed.

### § 103 Rejections of the Claims

Claims 17-36 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over McBrayer et al. (U.S. Patent No. 7,499,871, hereinafter "McBrayer") in view of Official

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<sup>17</sup> See, e.g., Office Action, page 2, "Means-plus-function language must be construed in accordance with 35 U.S.C. §, paragraph 6, by "look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent of the specification provides such disclosure." In re Donaldson Co., 16 F.3d 1189, 1193 (Fed. Cir. 1993) (en banc)."

<sup>18</sup> U.S. Published Patent Application No. 2005/0015325, FIG. 1 and paragraph 0037, emphasis added.

<sup>19</sup> *Id.* at paragraph 00120.

<sup>20</sup> *Id.* at FIG. 14 and paragraph 00126, reference numerals omitted, emphasis added.

Notice. A determination of obviousness requires a factual showing that “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”<sup>21</sup>

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.<sup>22</sup>

Applicants respectfully submit that a determination of obviousness is not established for the reason that the scope and content of the cited references, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements.

Each of independent claims 17, 28, 35, and 36 is amended herein to recite, in part, “the providing of the answer including **publishing the answer on the listing for the item.**”<sup>23</sup> This claim element was previously presented and examined with respect to claim 26, which is canceled herein. Subject matter support for this claim element may be found in Applicants’ specification, for example, at paragraph 0008.<sup>24</sup> Nothing in McBrayer mentions publishing the answer **on the listing for the item**. Although McBrayer states that “the question and answer [of McBrayer] may be made public and posted at the marketplace,”<sup>25</sup> McBrayer is silent with respect to publishing the answer **on the listing for the item**. Indeed, McBrayer contains no mention whatsoever of **publishing** or **a listing**, much less publishing an answer **on a listing**, let alone publishing an answer on a listing **for an item**. The deficiencies of McBrayer are not addressed by Official Notice. As a result, McBrayer and Official Notice do not teach or suggest the providing of the answer including publishing the answer on the listing for the item, as recited in the context of claims 17, 28, 35, and 36. Thus, the combination of McBrayer and Official Notice fails to teach or suggest at least this claim element.

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<sup>21</sup> *Graham v. John Deere*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

<sup>22</sup> *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007).

<sup>23</sup> Claims 17, 28, 35, and 36, emphasis added.

<sup>24</sup> U.S. Published Patent Application No. 2005/0015325, paragraph 0008, “an auction mechanism that would . . . have the seller post the relevant question as well as **a response for inclusion within a listing**,” emphasis added.

<sup>25</sup> McBrayer, column 5, lines 33-35.

Although dependent claims 18-27 and 29-34 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over McBrayer in view of Official Notice,<sup>26</sup> nothing in the Office Action articulates any specific reasoning to support these rejections. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some **articulated reasoning with some rational underpinning** to support the legal conclusion of obviousness.”<sup>27</sup> Moreover, “Patent and Trademark Office (PTO) must consider **all claim limitations** when determining patentability of an invention over the prior art.”<sup>28</sup> When determining whether a claim is obvious, an examiner must make “a searching comparison of the claimed invention – including **all its limitations** – with the teaching of the prior art.”<sup>29</sup> Accordingly, “obviousness requires a suggestion of **all limitations** in a claim.”<sup>30</sup> Applicants respectfully submit that the Office Action contains no discussion of any limitations recited in claims 18-27 and 29-34. As a result, in the Office Action, there is no articulated reasoning with any rational underpinning to support the legal conclusion of obviousness with respect to claims 18-27 and 29-34. Thus, a determination of obviousness has not been established with respect to claims 18-27 and 29-34, including claim 26, which is canceled herein.

For at least these reasons, the scope and content of McBrayer and Official Notice, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements. As a result, a determination of obviousness is not established with respect to any of independent claims 17, 28, 35, and 36, and their respective dependent claims, including claims 18-25, 27, and 29-34. Moreover, the dependent claims may each be patentable based on limitations recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

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<sup>26</sup> Office Action, page 8.

<sup>27</sup> *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007), quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), emphasis added; see also MPEP 2141.

<sup>28</sup> *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994), emphasis added.

<sup>29</sup> *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995), emphasis added; see also *Ex Parte Wada and Murphy*, Appeal No. 2007-3733 (B.P.A.I. 2008).

<sup>30</sup> *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003), citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974), emphasis added; see also *Ex Parte Wada and Murphy*, Appeal No. 2007-3733 (B.P.A.I. 2008).

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.

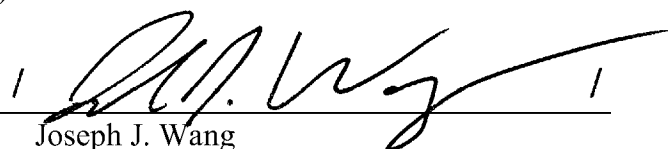
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Respectfully submitted,

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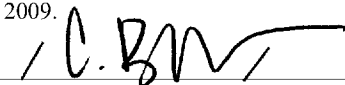
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By

  
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